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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,172	03/19/2004	Yoshifumi Sanuki	1046.1319	6771
21171 7590 01/30/2009 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
RUBIN, BLAKE J				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/804,172

**Applicant(s)**

SANUKI ET AL.

**Examiner**

BLAKE RUBIN

**Art Unit**

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

#### **DETAILED ACTION**

1. This action is a response to a request for continued examination filed December 9, 2008
2. Claims 22-25 are pending in this application. Claims 3, 5, 6, 8, 9, 12, 14, 15, 18, 20 and 21 are currently cancelled. Claims 22-25 are newly presented.
3. This application claims priority to Japanese Patent Application No. 2003-208295, filed 8/21/2003.

#### ***Claim Objections***

4. Claims 22-24 are objected to because of the following informalities:
  - a. Claims 22 and 24 recite, "an identifier" (line 7) which refers to an identifier already mentioned, the examiner suggests amending the claim to recite, "the identifier" in lines 7.
  - b. Claims 23 and 25 recite, "the first time", "an identifier", and "a response" when such reference have (or have not) been mentioned previously. The examiner suggest amending the claims to recite, "a first time", "the identifier", and "the response".

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**6. Claims 22 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

7. With respect to claim 22, the claim recites a apparatus to manage and control the issuance of assignment identifiers, all of which can be carried out exclusively in software, and is therefor directed to non-statutory subject matter. Without the embodiment of a physical apparatus on which the features of the claim are to be carried out the claim is interpreted as software per se.

8. With respect to claim 23, the claim fails to resolve the deficiency of the independent claim on which it is based, and is therefor rejected on the same grounds as above.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**10. Claims 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Massarani (U.S. Patent No. 6,393,484).**

11. With respect to claim 22, Massarani discloses an identifier assignment apparatus for assigning an identifier to a communication device that uses a unique identifier to perform communication (column 5, lines 60-65), comprising:

a managing unit (column 5, lines 60-65, *DHCP server*) managing a state (column 6, lines 60-65) and a valid term of the state relating to the communication device (column 7, lines 6-9, *lease times*); and

a control unit receiving a request from the communication device (column 5, lines 60-65, *routing switch gear*) and

if the state relating to the communication device is a permission for an assignment (column 6, lines 49-53, *"yes" condition*), assigning an identifier to the communication device in a response to the request (column 6, lines 49-53, *selects an appropriate IP address*) and extending the valid term for a predetermined period of time (column 7, lines 6-9), and

if the state relating to the communication device is a prohibition of an assignment (column 7, lines 24-26, *"provisional" state*), assigning no identifier to the communication device in a response to the request (column 7, lines 27-30) and extending the valid term for a predetermined period of time (column 7, lines 6-9).

12. With respect to claim 23, Massarani discloses an identifier assignment apparatus according to claim 22, wherein, when the request from the communication device is received for the first time (column 6, lines 23-25), the managing unit sets the state to an initial state (column 7, lines 24-26, *"provisional" state*) and the control unit assigns an identifier to the communication device in a response to the request (column 7, lines 34-36).

13. With respect to claim 24, Massarani discloses a computer-readable storage medium storing a program for assigning an identifier to a communication device that uses a unique identifier to perform communication (column 5, lines 60-65), the program when executed by a computer causes the computer to perform a method comprising:

managing a state (column 6, lines 60-65) and a valid term of the state relating to the communication device (column 7, lines 6-9, *lease times*); and

receiving a request from the communication device (column 5, lines 60-65, *routing switch gear*) and

if the state relating to the communication device is a permission for an assignment (column 6, lines 49-53, *"yes" condition*), assigning an identifier to the communication device in a response to the request (column 6, lines 49-53, *selects an appropriate IP address*) and extending the valid term for a predetermined period of time (column 7, lines 6-9), and

if the state relating to the communication device is a prohibition of an assignment (column 7, lines 24-26, *"provisional" state*), assigning no identifier to

the communication device in a response to the request (column 7, lines 27-30) and extending the valid term for a predetermined period of time (column 7, lines 6-9).

14. With respect to claim 25, Massarani discloses a computer-readable storage medium according to claim 25, wherein, when the request from the communication device is received for the first time (column 6, lines 23-25), the state is set to an initial state (column 7, lines 24-26, "*provisional*" state) and an identifier is assigned to the communication device in the response to the request (column 7, lines 34-36).

#### ***Response to Arguments***

15. Applicant's arguments with respect to claim 22-24 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Kubota et al Patent No. 6,647,009

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLAKE RUBIN whose telephone number is (571) 270-3802. The examiner can normally be reached on M-R: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

1/29/09

/Rubin Blake/  
Examiner, Art Unit 2457

/ARIO ETIENNE/  
Supervisory Patent Examiner, Art Unit 2457